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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,596	08/16/2001	Nigel John Middleton	27020/37460	6505

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT PAPER NUMBER

1772

DATE MAILED: 07/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,596

Applicant(s)

MIDDLETON, NIGEL JOHN

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 6, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-21, 27-34 and 38-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-21, 27-34 & 38-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☒ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 39 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis or support in the specification for the term “dome-like” in claims 39 and 40. The specification refers to the projections on the surface of the material as “dome projections.”

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 39 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “dome-like in claims 39 and 40 is unclear, which render the claims vague and

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indefinite. It is unclear from the specification and claim language what is meant by "dome-like". Both the claims and the specifications refer to "dome projections". How are "dome-like" and "dome" structurally different from each other?

Correction/clarification is required.

Applicant was contacted on July 8, 2003 about making an Examiner's amendment to claims 39 and 41 to change "dome-like" to "dome" in order to overcome the presented 35 U.S.C. 112 1st and 2nd paragraph rejections and put the application in an allowable state. However, in light of the new prior art, the application is no longer in a state for allowance. Both the 35 U.S.C. 112 1st and 2nd paragraph rejections will be overcome if the changes are made.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7 – 21, 27 – 34 and 38 – 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Middleton (WO 91/12958) in view of Nold (USPN 5,153,956).

Middleton discloses a breathable fabric or article formed from a sheet of impermeable

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material (Page 4, lines 14 – 19) with perforations in the material (Page 4, line 20 to Page 5, line 6) that is worn next to the skin of the user (Page 8, line 29 to Page 9, line 3). Projections having a dome shape (Figure 3 B) of the same height due to the same size of perforations (Page 12, lines 29 – 32) are formed on the surfaces of the fabric (Page 11, lines 18 – 23 and Figure 2a, #8). The projections are of a resilient material, which allows the perforations to remain open during the use of the article (Page 10, lines 5 – 13 and Page 17, lines 1 – 7). Chambers, depressions, (Figure 3A, #7) are formed in the material by the layers of materials and perforations, where the perforations are arranged to allow air to flow from surface of the sheet to the other by increased pressure (Page 2, lines 10 – 21). At the location of each perforation, a dome surrounds the outer surface (Page 11, lines 18 – 23 and Figure 2a). The formed sheet is used for a variety of different articles including different types of clothing, orthopedic supports, liners for casts and medical or veterinary dressings (Page 14, line 9 to Page 15, line 13). The layers are adhered on their surfaces by permanent adhesives (Page 10, lines 14 – 18). The breathable article or fabric is made from a laminate of materials, where the laminate includes woven, water-absorbent material (Page 4, lines 7 – 10) and vapor-permeable materials (Page 6, line 20 to Page 7, line 8). However, Middleton fails to disclose the spacer members projection from only the first or only the second major surface, the spacer members being discontinuous, the spacer members being continuous, the continuous spacer member extending across substantially all of at least one side of the sheet and the spacer members comprising a network of ribs on the respective side or sides of the sheet.

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Nold teaches a plurality of spacer members on the bottom surface, second surface, (Figure 2) which are located away from the through holes (Figure 2, #16) and permit the protrusions on the top surface to flex and bend when pressure is applied (Column 4, lines 49 – 59) in a cushioning layer (Column 5, line 31) for the purpose of supporting and lowering the amount of pressure between a body and a surface in order to help prevent bed sores.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the spacer members in Middleton in order to support and lower the amount of pressure between a body and a surface in order to help prevent bed sores as taught by Nold.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) Also, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape and location of the spacer members to make the continuous, discontinuous or in the shape of ribs. One skilled in the art would have been motivated to do so in order to separate the skin of the user from the fecal material deposited in the article.

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Response to Arguments

7. Applicant's arguments with respect to claims 7 – 21, 27 – 34 and 38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer
Examiner
Art Unit 1772

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pln

July 11, 2003



**WILLIAM P. WATKINS III
PRIMARY EXAMINER**